

REMARKS

Reconsideration is respectfully requested.

The Examiner's rejections will be considered in the order of their occurrence in the Office Action.

Paragraph 1 of the Office Action

The withdrawal of the indication of allowability of claim 3 and the rejection of claims 11, 12, and 18 are noted. A detailed response follows in conjunction with the response to paragraphs 2 through 6 of the office action.

Paragraphs 2 and 3 of the Office Action

Claim 1 has been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Steinhart (prior art previously cited) in view of Kidder et al. (prior art previously cited), Benjafield (prior art previously cited), and Ryan (previously cited).

It is respectfully submitted that the Examiner has improperly used applicant's claim 1 as a recipe for selecting and combining isolated elements of various references and has used the benefits achieved by applicant's claimed structure--benefits described only in applicant's disclosure--in hindsight as the motivation for making the asserted combination of references.

Presuming arguendo that the references show the elements or concepts urged by the examiner, the examiner has presented no line of reasoning, and we know of none, as to why the artisan viewing only the collective teachings of the references would have found it obvious to selectively pick and choose various elements and/or concepts from the several references relied on to arrive at the claimed invention. In the instant application, the examiner has done little more than cite references to show one or more elements or subcombinations thereof, when each is viewed in a vacuum, is known. The claimed invention, however, is clearly directed to a

combination of elements. That is to say, appellant does not claim that he has invented one or more new elements but has presented claims to a new combination of elements. To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

Ex parte Clapp, 227 USPQ 972, 973 (PTO Bd. App. 1985).

Withdrawal of the §103(a) rejection of claim 1 is therefore respectfully requested.

Paragraph 4 of the Office Action

Claims 11 and 18 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Steinhart (prior art previously cited) in view of Kidder et al. (prior art previously cited), Benjafield (prior art previously cited), and Ryan (previously cited).

It is further submitted that when a suggestion or motivation to combine selected elements of prior art references is not supplied by the prior art, the incentive to make such a combination can only come from improper hindsight reconstruction using the applicants' specification.

[T]he Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that '[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.' [citations omitted]

In re Fritch, 972 F.2d 1260; 23 USPQ2d 1780, 1784 (Fed. Cir. 1992), (in part quoting from In re Fine, 837 F.2d 1071, 1075; 5 USPQ2d 1596, 1600 (Fed. Cir. 1988)).

Withdrawal of the §103(a) rejection of claims 11 and 18 is therefore respectfully requested.

Paragraph 5 of the Office Action

Claims 11, 12 and 18 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Strong (prior art previously cited) in view of Hill (prior art previously cited), Benjafield (prior art previously cited), Steinhart (previously cited) and Ryan (previously cited).

It is further submitted that the need to combine a multiplicity of references in an attempt to meet the claimed invention is evidence of nonobviousness.

In this particular instance four references are combined. As discussed more fully above, the references must suggest the proposed combination in order to establish obviousness. Not only do none of the references suggest combination with any other single reference, there is absolutely no suggestion by any reference that as many as three other references should be combined with the potential primary reference.

Withdrawal of the §103(a) rejection of claims 11, 12 and 18 is therefore respectfully requested.

Paragraph 6 of the Office Action

Paragraph 6 of the Office Action states that claims 4-9 and 13-17 would be allowable if written into independent form with the limitations of the base claim and any intervening claims.

As discussed more fully above, the §103 (a) rejection of claims 1,11,12, and 18 are believed to be improper. It is again submitted that the need to combine a multiplicity of references in an attempt to meet the claimed invention is evidence of nonobviousness.

As discussed more fully above, the references must suggest the proposed combination in order to establish obviousness. Not only do none of the references suggest combination with any other single reference, there is absolutely no suggestion by any reference that as many as three other references should be combined with the potential primary reference. Therefore, it is again respectfully submitted that the Examiner has used the claim as a recipe to combine several references in an attempt to meet the claimed invention.

Claims 4-9 are dependent on claim 1, which is believed to be allowable. By virtue of dependence on claim 1, claims 4-9 are also believed to be allowable.

Claims 13-17 are dependent on claim 11, which is believed to be allowable. By virtue of dependence on claim 11, claims 13-17 are also believed to be allowable.

Paragraph 7 of the Office Action

Claim 10 is allowable over the prior art of record.